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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/804,953

03/19/2004

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11453.00

8082

29994 7590 05/08/2009
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EXAMINER

NORDMEYER, PATRICIA L

ART UNIT

PAPER NUMBER

1794

MAIL DATE

DELIVERY MODE

05/08/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/804,953	Applicant(s) BLANK ET AL.	
	Examiner Patricia L. Nordmeyer	Art Unit 1794	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 28 February 2009.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-28, 31-48 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-28 and 33-35 is/are allowed.
- 6) ☒ Claim(s) 31 and 36-43, 45, 46 and 48 is/are rejected.
- 7) ☒ Claim(s) 44 and 47 is/are objected to.
- 8) ☒ Claim(s) 32 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

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DETAILED ACTION

Withdrawn Rejections

1. Any rejections and or objections, made in the previous Office Action, and not repeated below, are hereby withdrawn due to Applicant's amendments and additional claims in the response dated February 28, 2009.

Election/Restrictions

2. Newly submitted claim 32 directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: Claim 32 is directed towards the method of using the roll in a printer.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for prosecution on the merits. Accordingly, claim 32 is withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claim 31 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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The phrases "For use in a printer having a feedpath terminating in a platen roller, thermal printing head, and cutting blade for dispensing a sequence of printed labels" and "said labels extend transversely across said web in cantilever from said narrow column to permit hand grasping of said adhesive-free remainder as said labels are sequentially printed by said printing head, individually cut by said blade, and dispensed from said printer by said platen roller" in claim 31 are unclear, which render the claim vague and indefinite. It is unclear from the added claim language what is trying to be claimed, the method of using the label roll, the label roll, an individual label or a combination of using the label and the label. It appears that body of the claim is directed towards the label roll while the preamble and last paragraph are directed towards method of using the claim.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 36 – 43, 45, 46 and 48 are rejected under 35 U.S.C. 103(a) as being unpatentable over Smith (USPN 5,578,352) in view of Slagsvol (USPN 4,884,826) and Lane (USPN 2,170,147).

Smith discloses a label roll (Column 1, lines 40 – 43) comprising web (Column 2, lines 54 – 58) that is continuous along said running axis and imperforate (Column 3, lines 6 and 7)

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having a front surface facing outwardly and an opposite back surface facing inwardly wound longitudinally along a running axis (Figure 2, #13 and 14) in a roll (Column 1, lines 40 – 43), said back surface including a plurality of non continuous adhesive patches (Column 3, line 60 to Column 4, line 1; Column 3, lines 42 – 46) aligned in a column along a running axis of said web in a minor area of said back surface with the remaining area of said back surface being devoid of adhesive (Figure 2, #34 and 35; Column 4, lines 16 – 18) and including adhesive-free spaces transversely bridging said web longitudinally between said adhesive patches to isolate said patches in sequential labels and permit cutting of said web in said adhesive-free spaces to separate said labels (Column 3, line 60 to Column 4, line 1; Column 3, lines 42 – 46, whereby the adhesive-free areas are formed in between the discontinuous strips) and said front surface including a release strip extending along said running axis behind said column of adhesive patches and laminated to said patches in successive layers in said roll (Column 3, lines 42 – 52) with said patches being sized for bonding an individual label to a surface (Figure 3, #11) in claim 36. With regard to claims 38 - 41, the patches are aligned along said edge of said web (Figure 2, #34 and 35), have straight edges aligned parallel and transversely with said running axis forming a rectangular shaped area (Figure 3) and are elongate along said running axis (Figure 2 and 3). The web further includes corresponding index marks between adjacent patches to define corresponding labels (Figure 3, #19) as in claims 42. With regard to claim 48, the web comprises printing paper (Column 2, lines 56 – 58); and the release strip is narrow to conform in width with said column of adhesive patches thereby leaving the remainder of the web front side devoid (Column 3, lines 48 – 42) and is made from a silicone coating (Column 3, line 33). As in claim 43, each of said labels has a plurality of said adhesive patches (Figure 2, #34 and 35).

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However, Smith fails to disclose , the patches being isolated on one side only of the transverse middle, the patches are aligned longitudinally in a narrow column along one lateral edge of said webs, and said labels extend transversely across said web in cantilever from said column to permit hand grasping of said adhesive-free remaining area as said labels are sequentially dispensed from said printer, being aligned on one lateral edge of the web and closer thereto than an opposite edge of said web, the patches have arcuate edges extending transversely with said running axis, convex leading edges with convex trailing edges connected by straight edges, ovals with major axes disposed parallel to the running axis, the patches being elongate transverse to said running axis, devoid of index marks and the release strip covering said web front side in full.

Slagsvol teach disclose the patches being isolated on one side only of the transverse middle (Figure 6, #2f; Column 2, lines 45 – 48), the patches are aligned longitudinally in a narrow column along one lateral edge of said webs, and said labels extend transversely across said web in cantilever from said column to permit hand grasping of said adhesive-free remaining area (Figure 6, #2f; Column 2, lines 45 – 48) being aligned on one lateral edge of the web and closer thereto than an opposite edge of said web (Figure 6, #2f; Column 2, lines 45 – 48) for the purpose of forming a paper that is easily and rapidly applied to a surface (Column 1, lines 43 – 44).

Lane teaches the patches of adhesive (Figure 1, #11; Page 2, Column 1, lines 33 – 38) being isolated on one side only of the transverse middle (Figure 9, #11) or being aligned on one

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lateral edge of the web and closer thereto than an opposite edge of said web (Figure 9, #11), the release strip covering said web front in full (Page 2, Column 1, lines 44 – 51) and devoid of index marks (Figure 1) for the purpose of being able to cut each band from a coated sheet without gumming the cutting knife and with fusing together the edges of the resulting bands (Page 3, Column 1, lines 15 – 20).

It would have been obvious to one of ordinary skill in the art at the time the applicant's invention was made to have provided a single adhesive patch isolated on one side only of the transverse middle, no index marks and a release strip covering said web front in full in Smith in order to form a paper that is easily and rapidly applied to a surface as taught by Slagsvol and to cut each band from a coated sheet without gumming the cutting knife and with fusing together the edges of the resulting bands as taught by Lane.

Regarding the patches having arcuate edges extending transversely with said running axis, convex leading edges with convex trailing edges connected by straight edges, ovals with major axes disposed parallel to the running axis, it is well settled that a particular shape of a prior invention carries no patentable weight unless the applicant can demonstrate that the new shape provides significant unforeseen improvements to the invention. See *In re Seid*, 161 F.2d 229, 73 USPQ 431 (CCPA 1947), *In re Dailey*, 357 F.2d 669, 149 USPQ 47 (CCPA 1966). In the instant case, the application does not indicate any new, significant attributes of the invention due to its shape, which would have been unforeseen to one of ordinary skill in the art. Therefore it would have been obvious to one of ordinary skill in the art at the time of the invention to change

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the shape of the adhesive patch as Smith teaches a variety of shapes being used (Column 3, line 60 to Column 4, line 1; Column 3, lines 42 – 46).

With regard to the limitations of “for printing in sequence individual labels therefrom in a printer including a feedpath extending longitudinally between inlet and outlet ends and terminating at said outlet end in a platen roller, printing head, and cutting blade transversely bridging said feedpath”, “to mount inside said printer at said inlet end”, “for being printed by said printing head”, “to engage said platen roller for dispensing said web from said roll”, “for reducing adhesive surface area exposure along said feedpath and over said platen roller”, “permit cutting of said web said by blade in said adhesive-free spaces to separate said labels” and “for bonding an individual label to a surface” in claim 36, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. The language of the claim is directed towards the structure of the label roll and not how the label roll is being used in combination with the printer or the cutting blade.

With regard to the limitation “to permit hand grasping of said adhesive-free remaining area as said labels are sequentially dispensed from said printer” in claim 37, a recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

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The language of the claim is directed towards the structure of the label roll and not how the label roll is being used in combination with the printer.

Response to Arguments

7. Applicant's arguments filed February 28, 2009 have been fully considered but they are not persuasive.

In response to Applicant's argument that Slagsvol and Lane are nonanalogous art relation neither to Applicants' field of endeavor or specific problems, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, a label, as defined by www.webster.com, is "a slip (as of paper or cloth) inscribed and affixed to something for identification or description". A label, as defined by www.dictionary.com, is "a slip of paper, cloth, or other material, marked or inscribed, for attachment to something to indicate its manufacturer, nature, ownership, destination, etc". Both Slagsvol and Lane become a label the moment a mark is made on the surface of tracing paper and the paper is stuck to the surface of an object and a mark is made on the surface of the gummed band of Lane and the band is adhered to the surface of an object, respectively. Therefore, Slagsvol and Lane are not considered non-analogous art based on the definition of a label as they are pertinent to the particular problem with which the applicant was concerned, the placement of adhesive on the pack surface of a web.

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In response to Applicant's argument that the Examiner is using hindsight to combine the references to construct the Applicant's invention, it must be recognized that any judgment on obviousness is in a sense necessarily a reconstruction based upon hindsight reasoning. But so long as it takes into account only knowledge which was within the level of ordinary skill at the time the claimed invention was made, and does not include knowledge gleaned only from the applicant's disclosure, such a reconstruction is proper. See *In re McLaughlin*, 443 F.2d 1392, 170 USPQ 209 (CCPA 1971). A label, as defined by www.webster.com, is "a slip (as of paper or cloth) inscribed and affixed to something for identification or description". Smith, Lane and Slagsvol all teach that it is known to use a variety of shapes of adhesive in combination with a web to form a label.

In response to Applicant's numerous arguments with regard to the shape of the adhesive patches and the Examiner failing to give weight to the shapes in combination with the printer elements, Applicant has not provided any evidence of unforeseen results due to the shape or placement of the adhesive patches. While the Examiner understands that the placement is key to use with a printer, the claims are directed towards a label, not a printer or a printer in combination with a label. All of the language presented with regard to the printer is in the intended use format, thereby causing no weight to be given to the printer as it does not result in a structural difference for the label. All of the evidence pointed out by the Applicant in the specification does not show unforeseen results; since by changing the placement resulting in no contact with specific elements of the printer would be obvious to one of ordinary skill in the art.

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Allowable Subject Matter

8. Claims 1 – 28, 33 - 35 are allowed.
9. Claims 44 and 47 objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Patricia L. Nordmeyer whose telephone number is (571)272-1496. The examiner can normally be reached on Mon.-Fri. from 10:00-6:30.

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If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David R. Sample can be reached on (571) 272-1376. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Patricia L. Nordmeyer
Primary Examiner
Art Unit 1794

/Patricia L. Nordmeyer/
Primary Examiner, Art Unit 1794